

*REMARKS/ARGUMENTS*

*Discussion of Amendments*

The specification has been amended to correct a word processing discrepancy; thus, the missing formula of compound 233 has been included at page 14, line 6, as supported by the originally filed application, e.g., Figure 21.

Claims 85-87, 90-93, and 95-97 have been amended to further sharpen the claim language or to expedite the prosecution of the application. Thus, claims 86, 92, and 96 have been amended to recite a method of treating breast cancer. Claims 85-87, 90-93, 95-97 have been amended to include a reference to an effective amount of the compound.

No new matter has been amended by way of these amendments.

*The Office Action*

The Office Action sets forth the following grounds of rejection:

- 1) The specification is objected to for an alleged informality;
- 2) claims 86, 92, and 96 are rejected under 35 U.S.C. 112, first paragraph, for an alleged nonenablement; and
- 3) Claims 81-87 and 90-97 are rejected for an alleged obviousness type double patenting as unpatentable over claims 1-47 of U.S. Patent No. 6,977,241 in view of Bottaro (WO 01/208577).

Claims 81-87 and 90-97 are allegedly directed to an invention not patentably distinct from claims 1-47 of commonly assigned U.S. Patent No. 6,977,241. The Office Action is asking the Applicants to show that the conflicting inventions were commonly owned at the time of the invention of the present application.

*Discussion of Rejections**A. Objection to the Specification*

Applicants have amended the specification as discussed. The specification amendment should overcome the informality objection to the specification.

*B. Non-Enablement Rejection*

Although Applicants disagree with the rejection, Applicants have amended the claims as discussed. The claim amendment renders the rejection moot. Accordingly, the non-enablement rejection should be withdrawn.

*C. Obviousness-Type Double Patenting Rejection*

Claims 81 and 83 are rejected for an obviousness-type double patenting as allegedly unpatentable over claims 1-41 of U.S. '241 in view of Bottaro et al. The Office Action alleges that claims 81 and 83 are not supported by the first priority document, U.S. Provisional Patent Application No. 60/226,671, filed August 22, 2000. Accordingly, the Office Action has assigned a priority date to claims 81 and 83, the filing date of the second priority document, U.S. Provisional Patent Application No. 60/392,028, filed June 28, 2002.

Applicants respectfully submit that the compounds of claim 81 and 83 are fully supported by the '671 application. See, for example, claim 5 of the '671 application, which shows the ring structure, the various substituents, and the stereochemistry of the bonds. The compound of claim 81 is fully supported by the disclosure of claim 5 and claims dependent thereon. See, particularly, claim 20, which is multiply dependent upon any one of claims 1-19. Claim 20 recites that  $R_6$  is  $C_2$ - $C_3$  alkenylenyl group; since  $C_3$  alkenylenyl is expressly recited, the  $R_6$  group of claim 81 is supported. Claim 19, upon which claim 20 depends from, recites that  $R_4$  and  $R_5$  form a cycloalkyl, particularly a  $C_6$  cycloalkyl, which supports the cyclohexyl group of the compound of claim 81. Further, claims 20 and 19 are dependent, by virtue of the multiple dependencies, upon claim 13, which recites that  $R_3$  is carboxymethyl, which supports the carboxymethyl group of the compound of claim 81. Furthermore, claim 11 recites  $R_2$  is phosphonomethyl, which supports the  $R_2$  group of the compound of claim 81. Additionally, claim 7 recites  $R_1$  is naphthylmethyl, which supports the naphthylmethyl group

of the compound of claim 81. Claims 20, 19, 13, and 11 are dependent upon claim 7, which is dependent upon claim 5. Thus, claim 20, by virtue of its dependency upon claims 1-19, particularly claims 5, 7, 11, 13, and 19, expressly recites the compound of claim 81 of the present application. Accordingly, the compound of claim 81 wherein  $R_3$  is carboxymethyl,  $R_2$  is phosphoromethyl,  $R_6$  is  $C_3$  alkenylenyl,  $R_1$  is naphthylmethyl, and  $R_4$  and  $R_5$  together form a  $C_6$  cycloalkyl, is fully supported by the first priority application as originally filed. Applicants, therefore, respectfully submit that the subject matter of claim 81 is entitled to the filing date of the first provisional application, and the obviousness-type double patenting rejection is erroneous and should be withdrawn.

In regards to claim 83, Applicants respectfully submit that the compound of claim 83 is fully supported by the '671 application. As discussed, claim 5 of the '671 application shows the ring structure, the various substituents, and the stereochemistry of the various bonds of the compound. The compound of claim 83 is fully supported by the disclosure of claim 5 and claims dependent thereon. See, particularly, claim 20, which is multiply dependent upon any one of claims 1-19. Claim 20 recites that  $R_6$  is  $C_2$ - $C_3$  alkenylenyl group; since  $C_3$  alkenylenyl is expressly recited, the  $R_6$  group of claim 83 is supported. Claim 19, upon which claim 20 depends from, recites that  $R_4$  and  $R_5$  form a cycloalkyl, particularly a  $C_6$  cycloalkyl, which supports the cyclohexyl group of the compound of claim 83. Further, claims 20 and 19 are dependent, by virtue of the multiple dependencies, upon claim 13, which recites that  $R_3$  is carboxymethyl, which supports the carboxymethyl group of the compound of claim 83. Furthermore, claim 9 recites  $R_2$  is dicarboxyalkyl wherein the alkyl portion of  $R_2$  is a  $C_1$ - $C_6$  alkyl, particularly  $C_1$  alkyl, which supports the  $R_2$  group (malonyl or dicarboxymethyl) of the compound of claim 83. Additionally, claim 7 recites  $R_1$  is naphthylmethyl, which supports the naphthylmethyl group of the compound of claim 83. Claims 20, 19, 13, and 9 are dependent upon claim 7, which is dependent upon claim 5. Thus, claim 20, by virtue of its dependency upon claims 1-19, particularly claims 5, 7, 9, 13, and 19, expressly recites the compound of claim 83 of the present application. Accordingly, the compound of claim 83 wherein  $R_3$  is carboxymethyl,  $R_2$  is malonyl,  $R_6$  is  $C_3$  alkenylenyl,  $R_1$  is naphthylmethyl, and  $R_4$  and  $R_5$  together form a  $C_6$  cycloalkyl, is fully supported by the first priority application as originally filed. The priority application has identified Applicants, therefore, respectfully submit that the subject matter of claim 83 is entitled to the filing date

of the first provisional application, and the obviousness-type double patenting rejection is erroneous and should be withdrawn.

In view of the foregoing, Applicants respectfully submit that U.S. '241 is not available as prior art against claims 81 and 83, and therefore, the obviousness-type double patenting rejection should be removed.

*D. Statement of Common Ownership*

Applicants submit that the presently claimed invention and U.S. Patent No. 6,977,241 were commonly owned at the time the presently claimed invention was made.

Accordingly, U.S. '241 should not be applied in any rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. § 102(e), (f), or (g).

*Conclusion*

A favorable decision is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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